



AF/3122
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: Todd Robert COLAS et al.

Examiner: Yehdega Retta

Appln No.: 09/935,120 ✓

Art. Unit: 3622

Filed: August 28, 2001

For: ELECTRONIC ADVERTISEMENT SYSTEM AND METHOD

PETITION TO EXERCISE SUPERVISORY AUTHORITY FOR WITHDRAWAL OF FINAL
REJECTION AS PREMATURE

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the above-captioned Application, Applicants hereby Petition For Withdrawal of the finality ✓
✓ of the Rejection, mailed on October 12, 2004, as premature, for reasons discussed in the following
remarks.

I. BACKGROUND

In a non-final Office Action dated March 15, 2004 the Examiner rejected claims 1-4, 20, 25 and 26 under 35 USC §103(a) as being unpatentable over Kashino (U.S. Patent No. 6, 166, 716), in view of Lynn et al. (U.S. Patent No. 6,606,740) and rejected claims 5-19 and 21-24 under 35 USC §103(a) as being unpatentable over Kashino (U.S. Patent No. 6, 166, 716), in view of Lynn et al. (U.S. Patent No. 6,606,740) and further in view of Johnson et al. (U.S. Patent No. 6,453,302).

Subsequent to the non-final Office Action an Office Interview was conducted with the Examiner, Applicants, and Applicants' representative on June 23, 2004. During the Office Interview the Examiner mentioned that the claimed feature, "means for specifying business rules and roles, was broadly interpreted which was different from what Applicant's (sic Applicants') invention is" and suggested that applicants amend the independent claims, to which suggestion Applicants agreed.

In an amendment filed subsequent to the Office Interview on July 15, 2004, Applicants' narrowed the independent claims in accordance with the agreement reached during the Office Interview, i.e., in accordance with the Examiner's suggestion to narrow the independent claims to more narrowly state a template means for specifying business rules and roles rather than means for specifying business rules and roles. As a result of amending the claim language of the independent claims 1, 10, and 20 it was necessary to amend dependent claims 3, 5, 6, 10, 12, 21, 22, and 23 to conform to U.S. claiming practice. The scope of the amended dependent claims was either narrowed or remained the same and no new matter was added by any of these amendments to the claims.

In the Final Rejection of October 12, 2004, the Examiner did not rely on any of Kashino, Lynn and Johnson nor even a 35 U.S.C. 103 rejection as before, but, rather set forth a rejection of all claims 1-26 under of 35 U.S.C. §102(b) as being anticipated by Celebro as taught in newly found references consisting of article "Tech Tapped To Protect Classifieds" NEXPO97, NAA Presstime, article "GMTI To Giveaway Roles Watch at NEXPO 2000", and article Gannett Media Technologies International and newsletter Celebro.communiqué, 1st quarter 2000.

II. SPECIFIC RELIEF REQUESTED

Applicants respectfully request that the finality of the Rejection, mailed on October 12, 2004, be withdrawn as premature.

III. ARGUMENTS

The Examiner alleges that Applicants' amendment of the claims necessitated the new ground(s) of rejection presented in the Final Rejection. Since Applicants only amended the claims either to narrow an already claimed limitation recited by an independent claim, or to conform dependent claims to U.S. practice as a result of a narrowing amendment to a superior claim, this is not a case where the examiner was forced to cite new references because of Applicants' amendments to the claims but rather because the Examiner became aware of new prior art. In such a case, Applicants have been denied due process in not being able to respond to newly cited art recently located by the Examiner but not

necessitated by amendment of Applicants' claims. The Final Rejection is the first time Applicants are seeing the Examiner's 35 U.S.C. 102(b) rejection and due to the finality of the rejection are constrained from responding by adding additional claims, amending the existing claims or presenting showings, all to be entered as a matter of right.

Applicants respectfully assert that in making the 35 U.S.C. 102(b) rejection of the above-listed claims in the Final Rejection, the Examiner has introduced a new ground of rejection that is not necessitated by applicant's amendment of the claims, thereby rendering the Final Rejection premature (MPEP §706.07(a)).

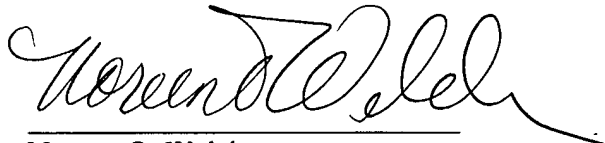
If any issues remain which may be best resolved through a telephone communication, the undersigned kindly invites a telephone call at the local, Washington D.C. telephone number listed below.

If any Petition Fee is necessary, please charge the Petition Fee to the undersigned; deposit account No. 19-4375

Respectfully submitted,



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Date: October 27, 2004

NOW/att

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